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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,845	04/26/2000	HIDENORI FUNAMIZU	2554-7	5849

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/485,845

Applicant(s)
FUNAMIZU et al.

Examiner
Brenda Coleman

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 28, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-76 and 85 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-76 and 85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 67-76 and 85 are pending in the application.

This action is in response to applicant's amendment filed April 28, 2003. Claims 67-71 and 73-76 were amended, claims 61-66 and 77-84 were canceled and claim 85 is newly added.

Response to Amendment

Applicant's arguments filed April 28, 2003 have been fully considered with the following effect:

1. With regards to the rejection as being drawn to an improper Markush group of the last office action, the applicant's failed to comment on this rejection and is therefore herein maintained.

Claims 67-76 and newly added claim 85 are rejected as being drawn to an improper Markush grouping. For reasons of record and stated above.

2. With regards to the 35 USC § 112, enablement rejection labeled paragraph 2 of claims 61, 62, 64, 66 and 68-84 maintained in the last office action, the applicant's failed to comment on this rejection and is therefore herein maintained.

Claims 67-76 and newly added claim 85 are rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For the reasons stated above and in the last office action.

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3. The applicant's amendments are sufficient to overcome the 35 USC § 112, first paragraph rejection labeled 3b maintained in the last office action, which is hereby **withdrawn**.
4. The applicant's amendments are sufficient to overcome the 35 USC § 112, second paragraph rejections labeled 4h), 4q), 4s), 4w) and 7aa) maintained in the last office action, which are hereby **withdrawn**.
5. The applicant's amendments are sufficient to overcome the 35 USC § 112, second paragraph rejections labeled 10e), 10f), 10g-j), 10k) and 10n) maintained in the last office action, which are hereby **withdrawn**.
6. The applicant's amendments are sufficient to overcome the 35 USC § 112, first paragraph rejections labeled 11a), 11b), 11c) and 11d) of the last office action, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, first paragraph rejection labeled 11e) of the last office action, the applicant's failed to comment on this rejection and is therefore herein maintained.

Claim 69 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For reasons of record and stated above.

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7. The applicant's amendments are sufficient to overcome the 35 USC § 112, second paragraph rejections labeled 12a)-12y) of the last office action, which are hereby **withdrawn**.

In view of the amendment dated April 28, 2003, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 85 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a) The definition of A₁ includes a moiety which is not described in the specification. 1,4-dioxo-2,3-dihydro-benzo[1,5]thiazepine is not exemplified in the list of rings which are contemplated for A¹ in the specification on page 11.
- b) The definition of D where D is -NH-CH₂-CH(OH)-CH₂-NH-CH₂-CH(OH)-CH₃ is not described in the specification.

Applicant is required to cancel the new matter in the reply to this Office action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
July 3, 2003